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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,837	09/17/2003	James T. Perkins	P03320	4911
23702 7590 01/17/2007 Bausch & Lomb Incorporated One Bausch & Lomb Place Rochester, NY 14604-2701			EXAMINER THANH, LOAN H	
			ART UNIT 3763	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/17/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/664,837

Applicant(s)

PERKINS ET AL.

Examiner

LoAn H. Thanh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10/12/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2,5-6,9-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

The claim objections have been obviated in view of the amendment filed 10/12/06.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2,5-6,9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zadno-Azizi et al. (US 5,997,562) in view of Eliassen et al. ( US 6,332,874).

Zadno-Azizi et al. disclose a cannula/needle having a hub 3, an elongated needle 12 having a first and second inner diameter/bore 14a,b respectively wherein the first inner diameter/bore 14a extending from the distal end toward the proximal end is larger than the second inner diameter/bore 14b and wherein the transition region 21 has a radius and is closer to the proximal end than the distal end. With respect to claim 1 and the limitation of the "wherein..." clause, the Examiner is taking the position that since the cannula/tubular element is disclosed as being made of various materials from various polymer material or metallic hypotube with a hub attached to the end, it is capable to engage the hub with a phacoemulsification surgical instrument for transferring ultrasonic energy to the needle if so desired. Zadno-Azizi et al. shows a

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luer lock 3 on the hub. Zadno-Azizi et al. teach that connectors can be made in different ways. Zadno-Azizi et al. show one embodiment to be a luer connector and mentions another such as friction fit, or a ridged-groove connection. Zadno-Azizi et al. realizes that any connector is possible to provide for a connection between a hub and another device. Eliassen et al. (US 6,332,874) disclose a catheter/tubular system which provides for a threaded connection 24 at the proximal end to another device.

Specifically, Eliassen teaches luer connector threads 24 formed on a coupling hub 26. It would have been obvious to one of ordinary skill in the tubular devices in the medical arts to modify or substitute the luer connector of Zadno-Azizi et al. with a luer connector which is threaded as taught by Eliassen et al. in order to provide a secure connection between elements.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-2, 5-6, 9-10 filed 10/12/06 have been considered but are moot in view of the new rejection.

Applicant is reminded that the functional limitation of "for engagement with a phacoemulsification instrument" has not been positively recited and only functionally recited. Further, the wherein clause is functionally related to the surgical instrument and thus only needs to meet the claim as being capable of performing the function in as much as has been claimed.

Applicant's arguments are directed to the intended use of the device. Applicant has not structurally claimed a limitation or feature which would distinguish over the prior

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art of record. Applicant's language of "capable of" is considered broad and the Examiner is only required to find a threaded hub "for engagement with ..." which would be capable of being connected to a surgical instrument. The Examiner agrees with applicant that functional characterization of the invention is an acceptable patent technique, however, the prior art still anticipates applicant's broad and functional language.

### ***Conclusion***

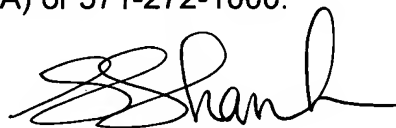
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (571) 272-4966. The examiner can normally be reached on Mon. - Fri. (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
LoAn H. Thanh  
Primary Examiner  
Art Unit 3763

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